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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: 3747

RYAN McGEE et al.

Examiner: Johnny H. Hoang

Serial No.: 10/709,537

Filed: May 12, 2004

For: METHOD FOR CONTROLLING STARTING OF AN
ENGINE IN A HYBRID ELECTRIC VEHICLE
POWERTRAIN

Attorney Docket No.: 81070752/FMC1568PUS

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a response to the Restriction Requirement of June 23, 2005.

Applicants elect for further prosecution in this application the claims of Group

I. Included in Group I are claims 1-4, 8-10, 22-23.

The requirement for restriction is respectfully traversed since, in Applicants' view, it is improper. Applicants do not agree that the subject matter of the claims of Group I are distinct patentably from the subject matter of the claims of Group II. In the Examiner's discussion of the reasons for the requirement for restriction, it is stated that the inventions of the two claim groups are related as sub-combinations that are usable together in a single

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combination. Actually, the claims of each group recite the Applicants' engine smoothness factor determination method as a single method, the claim scope for each group being defined by language of varied broadness. Claim 1, for example, recites an internal combustion engine in the preamble of the claim. The method steps that follow the preamble define the steps used in determining the several smoothness factors. Claim 2, which also is in Group I, additionally recites the step of adjusting engine start smoothness using one of several operating variables for the engine. Claim 5, which is in Group II, recites essentially similar method steps for determining smoothness factor as well as steps for determining the operating variables. Claim 6, which also is in Group II, additionally recites the step of adjusting the engine start smoothness using one of the operating variables.

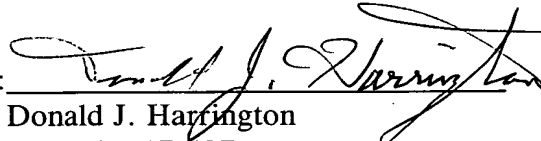
The only justification for the restriction requirement set forth in the Office Action is stated to be that the claims of Group I recite an internal combustion engine, whereas the claims of Group II recite an accelerator controlled engine. This, in Applicants' view, is not a valid justification for a restriction requirement. The claims of Group II clearly are related to the claims of Group I. The accelerator position, which is mentioned in claim 5 of Group II, is merely one of the engine operating variables for determining a temporary smoothness factor. In Applicants' view, the requirements for restriction set forth in Section 806.05(d) of the MPEP are not satisfied. In any case, the burden is on the Examiner to provide an example wherein one of the so-called sub-combinations has utility other than in the disclosed combination. This has not been done in the Office Action.

Notwithstanding the foregoing, claim 5 of Group II, as well as other claims in Group II, can be considered to be a species under the claimed genus of claim 2 of Group I, as well as under other claims of Group I. The accelerator position recited in claim 5 is merely one of the operating variables recited in claim 2. Thus, there is a genus-species relationship between the claims of Group I and the claims of Group II.

It is respectfully requested that the requirement for restriction be reconsidered and withdrawn, and that an examination be made on the merits of claims 1-23.

Respectfully submitted,

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